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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/390,079	09/03/1999	DARREN KERR	112025-0167	6305

7590 11/23/2005
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EXAMINER

ELLIS, RICHARD L

ART UNIT	PAPER NUMBER
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2183

DATE MAILED: 11/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/390,079	Applicant(s) KERR ET AL.	
	Examiner Richard Ellis	Art Unit 2183	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 67-117 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 67-117 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Claims 67-117 remain for examination.
2. The text of those sections of Title 35, US Code not included in this action can be found in a prior Office Action.
3. Claim 117 is rejected under 35 USC § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e., as lacking adequate written description.
4. Claim 117 is rejected under 35 USC 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.
5. Claims 67-72, 78-97, and 104-117 are rejected under 35 USC § 102(b) as being clearly anticipated by Hao et al., U.S. Patent 4,594,655.
6. Claims 73-77 and 98-103 are rejected under 35 USC § 103 as being unpatentable over Hao et al., U.S. Patent 4,594,655, as applied to claims 67-72, 78-97, and 104-116, in view of Asato, U.S. Patent 6,145,074.

Hao and Asato were cited as prior art references in paper number 20050526, mailed June 3, 2005.
7. The rejections are respectfully maintained and incorporated by reference as set forth in the last office action, paper number 20050526, mailed June 3, 2005.
8. Applicant's arguments filed September 6, 2005, paper number 20050906, have been fully considered but they are not deemed to be persuasive.
9. In the remarks, applicant argues in substance:
 - A. That: "The computer readable media claim makes a knock off artist a direct infringer. Furthermore, the computer readable media claim includes preventing downloading a file from a web site. Downloading a file is inherent knowledge of every computer programmer. That is anyone that can design the invention under claims 67, 84, 92, or 111 has the ordinary skill in the art to design the invention under claim 117. Therefore, claim 117 should be allowable."

This is not found persuasive because applicant's arguments indicate that claim 117 is

either inherently known to every computer programmer and/or that claim 117 is obvious to one of ordinary skill in the art. Applicant is reminded that in order to be allowable, a claim must not be inherently known and must also be non-obvious. Applicant has now placed of record within the application history an explicit statement that claim 117 is both inherent to any computer programmer, and is obvious to anyone of skill in the relevant art. Applicant's statement indicates that the claim can never be allowed.

Furthermore, there is no basis in the patent statutes for a claim to be allowable because it causes a certain group of individuals to become infringers. The basis for allowable claims in the patent statutes is that the invention must be novel and non-obvious. However, as pointed out above, applicant has admitted that claim 117 is both non-novel and obvious.

B. That: "The geometry in Hao does not disclose use of a *Multiplexer*." (emphasis unchanged)

"In paragraph 8(D) of the Office Action, the Examiner states that element 22 in Figure 1 is a multiplexer. However, at Col. 6, line 8, the specification states "three-input binary adder 22."

"Hao is silent describing using a multiplexer to select inputs for an ALU"

This is not found persuasive because had applicant read the entire citation, and not just the last two words, he would have found this statement:

"mux shown just above the letter A at element 22"

Element 22 was not being referenced as the mux, but was being referenced as a relative location point to allow applicant to locate the mux. Furthermore, Hao explicitly details multiplexers at col. 6 lines 29-35:

The secondary execution unit (left portion of FIG. 1) comprises a limited set of functional organs, including ... input multiplexers ..."

Accordingly, Hao does indeed both show in the drawings and disclose in the text a mux, contrary to applicant's arguments.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a

final rejection has been discontinued by the Office. See 1021 TMOG 35.


A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Richard Ellis whose telephone number is (571) 272-4165. The Examiner can normally be reached on Monday through Thursday from 7am to 5pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eddie Chan, can be reached on (571) 272-4162. The fax phone number for the USPTO is: (703)872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-2100.

Richard Ellis
November 17, 2005



RICHARD L. ELLIS
PRIMARY EXAMINER